

REMARKS

By this Amendment, Applicants amend claims 3, 21-25, and 29, and cancel claims 4, 5, 15-20, and 26-28 without prejudice or disclaimer. Claims 3, 21-25, and 29 are now pending in this application.

In the Office Action,¹ the Examiner rejected claims 3-5 and 15-20 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Examiner also rejected claims 3-5 and 15-29 under 35 U.S.C. § 102(e) as being anticipated by Tagawa et al. (U.S. Patent Publication No. 2004/0197084 A1).

I. REJECTION OF CLAIMS 3-5 AND 15-20 UNDER § 101

Although Applicants respectfully traverse the rejection of claims 3-5 and 15-20 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter, Applicants note that with respect to canceled claims 4, 5, and 15-20, the rejection is now moot. Furthermore, with regard to claim 3, Applicants have amended the claim to recite a “computer-readable information storage medium storing program instructions to cause a processor to execute a method for playing information and image information.” As indicated in MPEP § 2106, “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.” See MPEP § 2106, IV.B.1.(a).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Accordingly, claim 3 recites statutory subject matter and Applicants request that the rejection of the claim under 35 U.S.C. § 101 be withdrawn.

II. REJECTION OF CLAIMS 3-5 AND 15-29 UNDER § 102(e)

Applicants respectfully traverse the rejection of claims 3-5 and 15-29 under 35 U.S.C. § 102(e) as being anticipated by Tagawa, and note that with respect to canceled claims 4, 5, 15-20, and 26-28, the rejection is now moot. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See MPEP § 2131, *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." MPEP § 2131. In this application, all elements of the claims are not taught by the applied reference.

Independent claim 3, as amended, recites a combination including, among other things, "a management area configured to store management information" including "second sub-management information" that "includes numeral information describing a number status of the still images." Tagawa does not disclose or suggest at least these elements of independent claim 3.

By contrast, according to the Tagawa system, Default Playlist General Information includes a unique identifier and a field in which a total playback time of all the tracks in a playlist are written. See page 34, paragraph [0706]. The Tagawa

system provides for playback of still images during the playback of a track. See page 34, paragraph [0721]. A “Display Further, a “Display Order Mode” indicates an order in which the images (referred to as picture objects or POBs) are to be displayed and a “Display Timing Mode” indicates whether to synchronize the images with corresponding audio. See pages 34-35, paragraphs [0723] to [0729]. Furthermore, the “POB_ROC” field indicates whether the display of a picture object (“POB”) is specified by default play list general information (“DPLGI”), playlist general information (“PLGI”), or track general information (“TKGI”). See paragraph [0796]. The “POB_ROC” field, however, does not teach the claimed “second sub-management information” that “includes numeral information describing a number status of the still images,” as required by independent claim 3. Accordingly, since Tagawa does not teach all of the elements of independent claim 3, the Examiner should withdraw the rejection of independent claim 3 under 35 U.S.C. § 102(e).

Independent claims 21-25 and 29, while of a different scope from independent claim 3, have been amended to include recitations of a scope similar to independent claim 3. Accordingly, independent claims 21-25 and 29 are not taught by Tagawa for at least the reasons discussed above. Therefore, the Examiner should also withdraw the rejection of claims 21-25 and 29 under 35 U.S.C. § 102(e).

CONCLUSION

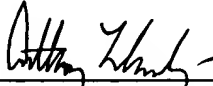
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 21, 2006

By: 
Anthony J. Lombardi
Reg. No. 53,232